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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,425	12/05/2003	Gerald David Appel	049982-0310127	8392

27500 7590 12/03/2004

PILLSBURY WINTHROP LLP  
ATTENTION: DOCKETING DEPARTMENT  
11682 EL CAMINO REAL, SUITE 200  
SAN DIEGO, CA 92130

EXAMINER

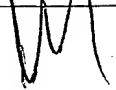
MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/729,425	Applicant(s) APPEL ET AL. 	
	Examiner Charles A. Marmor, II	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03082004</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: In line 2 of the paragraph under "Cross-Reference To Related Applications" the current status of U.S. Application No. 09/901,992 should be provided. Appropriate correction is required.
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 8, 10, 16-18, 25, 27, 33-37, 42, 44, 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Toomim et al. ('208). Toomim et al. discloses a method and system for determining muscle dysfunction including steps of selecting a plurality of sites for sensing muscle activity (column 4, lines 30-37), calculating adipose thickness factors for a

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plurality of sites (column 5, lines 10-13), making electrical activity measurements for the plurality of sites (column 4, lines 50-55), and analyzing the electrical activity measurements using a processor (column 8, lines 50-55) and factoring the adipose thickness factors into the measurements for each of the sites of the electrodes, the adipose thickness factors from sampling a group of individuals (column 5, lines 19-22), and calculating the degree of departure from a normal condition (column 8, lines 18-30), mapping the degree of departure from a normal condition (column 6, lines 46-50) and a computer readable medium for calculating adipose thickness factors and analyzing electrical activity measurements in the form of software within the processor (column 6, lines 47-60) and a report for reading the information (column 5, lines 23-67 and column 8, lines 45-50).

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 3-7, 9, 11-15, 19-24, 26, 28-32, 38-41, 43, 46-58 and 61 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-43 of prior U.S. Patent No. 6,280,395. This is a double patenting rejection. Claims 3-7 of the present application claim the

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same invention as claims 1-5 of the patent, respectively. Claim 9 of the present application claims the same invention as claim 6 of the patent. Claims 11-15 of the present application claim the same invention as claims 7-11 of the patent, respectively. Claims 19-24 of the present application claim the same invention as claims 12-17 of the patent, respectively. Claim 26 of the present application claims the same invention as claim 18 of the patent. Claims 28-32 of the present application claim the same invention as claims 19-23 of the patent, respectively. Claims 38-41 of the present application claim the same invention as claims 24-27 of the patent, respectively. Claim 43 of the present application claims the same invention as claim 28 of the patent. Claims 46-58 of the present application claim the same invention as claims 30-42 of the patent, respectively. Claim 61 of the present application claims the same invention as claim 43 of the patent.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 8, 18, 25, 35-37, 42 and 60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-8, 12, 17-20, 24-30,

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34, 35 and 43 of U.S. Patent No. 6,280,395. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are merely broader than the claims of the patent. Claim 1 of the present application is merely broader than claims 1 and 5 of the patent. Claim 2 of the present application is merely broader than claim 1 of the patent. Claim 8 of the present application is merely broader than claims 6-8 of the patent. Claim 18 of the present application is merely broader than claims 12 and 17 of the patent. Claim 25 of the present application is merely broader than claims 18-20 of the patent. Claim 35 of the present application is merely broader than claims 24-27 of the patent. Claims 36 and 37 of the present application are merely broader than claims 24-26 of the patent. Claim 42 of the present application is merely broader than claims 28-30, 34 and 35 of the patent. Claim 60 of the present application is merely broader than claim 43 of the patent.


### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

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November 29, 2004